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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This Appeal Brief is filed pursuant to the Notice of Appeal filed November 26, 2007 and in response to the Notice of Panel Decision from Pre-Appeal Brief Review dated January 25, 2008.

1. *Real Party in Interest.*

The real party in interest in this appeal is Nokia Corporation, the assignee of the above-referenced patent application.

2. *Related Appeals and Interferences.*

There are no related appeals and/or interferences involving this application or its subject matter.

3. *Status of Claims.*

The present application currently includes claims 15-57, which all stand rejected. Claims 1-14 are canceled without prejudice or disclaimer. The rejection of claims 15-57 is being appealed.

4. ***Status of Amendments.***

There are no unentered amendments in this application.

5. ***Summary of Claimed Subject Matter.***

Independent claim 15 is directed to a method for handling messages (e.g., element 50, element 51 and element 52 of FIG. 5) transmitted between communication terminals (e.g., element 1 of FIG. 1 & FIG. 2) via a wireless network (e.g., pg. 4, lines 13-14, pg. 5, lines 5-8). The method (e.g., FIG. 3) comprises generating (e.g., element 35 of FIG. 8; pg. 8, lines 7-9) a compound message including a text part and at least one graphical icon part (e.g., pg. 6, line 32 to pg. 7, line 9; pg. 7, lines 11-17; FIG. 5 and element 102 of FIG. 3; FIG. 6). The compound message generation includes reading (e.g., element 30 of FIG. 8; pg. 7, lines 28-30; pg. 8, lines 4-6; element 111 of FIG. 4) a user inputted text part and converting the inputted text part into a predefined message text format (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15) and adding a graphical part (e.g., element 51 & element 52 of FIG. 5; FIG. 6; pg. 6, lines 4-6; pg. 8, lines 16-24) to the message (e.g., pg. 2, lines 1-5; pg. 7, lines 28-30). The graphical part includes a record for each of the at least one graphical icon part in a graphical format, (e.g., pg. 2, lines 5-7) and position information is added in the message (e.g., pg. 2, lines 7-8; pg. 3, lines 1-2; element 102 of FIG. 3) defining a position (e.g., pg. 9, lines 3-5; FIG. 6) of the at least one graphical icon part in the text part. The method further comprises transmitting the message via the wireless network (e.g., pg. 8, lines 10-12; element 117 of FIG. 4).

Independent claim 16 is directed to a communication terminal (e.g., element 1 of FIG. 1 & FIG. 2) for handling messages (e.g., FIGS. 5 & 6). The communication terminal (e.g., element 1 of FIG. 1) comprises a controller, (e.g., element 18 of FIGS. 2 & 8) a transceiver (e.g., element 19 of FIG. 2) for communicating with a wireless communication network, (e.g., pg. 5, lines 5-8) and a user interface (e.g., pg. 5, lines 1-5; FIG. 2) through which the user operates the terminal. The user interface includes a display message editor application (e.g. element 31 of FIG. 8) allowing the user to generate (e.g., element 35 of FIG. 8; pg. 8, lines 7-9) a compound message including a text part and at least one graphical icon part (e.g., pg. 6, line 32 to pg. 7, line 9; pg. 7, lines 11-17; FIG. 5 and element 102 of FIG. 3; FIG. 6). The controller generates (e.g., element 18 & element 35 of FIG. 8; pg. 8, lines 7-9) the compound

message for being transmitted via the transceiver (e.g., pg. 8, lines 10-12; element 19 of FIG. 2 & element 117 of FIG. 4) including a text part in a predefined message text character format (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15), a graphical part including a record (e.g., pg. 2, lines 5-7) for each of the at least one graphical icon part in a graphical format, and information in the message defining a position (e.g., pg. 9, lines 3-5; FIG. 6) of the at least one graphical icon part in the text part.

Independent claim 25 is directed to a message format (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15) including a text part (e.g., element 50 of FIG. 5) and at least one graphical icon part (e.g., element 51, element 52 of FIG. 5; FIG. 6), comprising a text part in a predefined message text character format (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15) and a graphical part including a record (e.g., pg. 2, lines 5-7) for each of the at least one graphical icon part in a graphical format. Information in the message defines a position of the at least one graphical icon part in the text part (e.g., pg. 2, lines 7-8; pg. 9, lines 3-5; FIG. 6).

Independent claim 29 is directed to a method for handling messages (e.g., FIGS. 5 & 6) transmitted between communication terminals (e.g., element 1 of FIG. 1 & FIG. 2) via a wireless network (e.g., pg. 4, lines 13-14, pg. 5, lines 5-8). The method comprises generating (e.g., element 35 of FIG. 8; pg. 8, lines 7-9) a compound message (e.g., FIGS. 5 & 6) including a text part (e.g., element 50 of FIG. 5) and at least one graphical part (e.g., element 51 and element 52 of FIG. 5). The compound message generation includes reading (e.g., element 30 of FIG. 8; pg. 7, lines 28-30; pg. 8, lines 4-6; element 111 of FIG. 4) a user inputted text part and converting the inputted text part into a predefined message text format, (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15) and adding a graphical part to the message (e.g., element 51 & element 52 of FIG. 5; FIG. 6; pg. 6, lines 4-6; pg. 8, lines 16-24). The graphical part includes a record (e.g., pg. 2, lines 5-7) for each of the at least one graphical part in a graphical format, and position information (e.g., pg. 2, lines 7-8; pg. 3, lines 1-2; element 102 of FIG. 3) is added in the message defining a position (e.g., pg. 9, lines 3-5; FIG. 6) of the at least one graphical part in the text part. The method further comprises transmitting of the message via the wireless network (e.g., pg. 8, lines 10-12; element 117 of FIG. 4).

Independent claim 30 is directed to a communication terminal (e.g., element 1 of FIG. 1; FIG. 2) for handling messages (e.g., FIGS. 5 & 6). The communication terminal (e.g.,

element 1 of FIG. 1; FIG. 2) comprises a controller, (element 18 of FIGS. 2 & 8) a transceiver (e.g., element 19 of FIG. 2) for communicating with a wireless communication network (e.g., pg. 5, lines 5-8), and a user interface (e.g., pg. 5, lines 1-5; FIG. 2) through which the user operates the terminal. The user interface includes a display message editor application (e.g., element 31 of FIG. 8) allowing the user to generate (e.g., element 35 of FIG. 8; pg. 8, lines 7-9) a compound message including a text part and at least one graphical part. The controller generates (e.g., element 18 & element 35 of FIG. 8; pg. 8, lines 7-9) the compound message for being transmitted via the transceiver (e.g., pg. 8, lines 10-12; element 19 of FIG. 2 & element 117 of FIG. 4) including a text part in a predefined message text character format, (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15) and a graphical part including a record (e.g., pg. 2, lines 5-7) for each of the at least one graphical part in a graphical format. Information in the message defines a position (e.g., pg. 9, lines 3-5; FIG. 6) of the at least one graphical icon part in the text part.

Independent claim 39 is directed to a message format (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15) including a text part (e.g., element 50 of FIG. 5) and at least one graphical part, (e.g., element 51, element 52 of FIG. 5; FIG. 6) comprising a text part in a predefined message text character format (e.g., pg. 2, lines 3-5, 30-31; pg. 11, lines 26-32 and pg. 12, lines 1-15) and a graphical part including a record (e.g., pg. 2, lines 5-7) for each of the at least one graphical part in a graphical format. Information in the message defines a position (e.g., pg. 9, lines 3-5; FIG. 6) of the at least one graphical part in the text part.

Dependent claim 46 is directed to the method of independent claim 15 in which the at least one graphical icon part comprises at least one of an image or a picture (e.g., element 51 and element 52 of FIG. 5; FIG. 6; pg. 7, lines 1-21).

Dependent claim 47 is directed to the communication terminal of independent claim 16 in which the at least one graphical icon part comprises at least one of an image or a picture (e.g., element 51 and element 52 of FIG. 5; FIG. 6; pg. 7, lines 1-21).

Dependent claim 48 is directed to the message format of independent claim 25 wherein the at least one graphical icon part comprises at least one of an image or a picture (e.g., element 51 and element 52 of FIG. 5; FIG. 6; pg. 7, lines 1-21).

Dependent claim 49 is directed to the method of independent claim 29 wherein the at least one graphical part comprises at least one of an image or a picture (e.g., element 51 and

element 52 of FIG. 5; FIG. 6; pg. 7, lines 1-21).

Dependent claim 50 is directed to the communication terminal of independent claim 30 in which the at least one graphical part comprises at least one of an image or a picture (e.g., element 51 and element 52 of FIG. 5; FIG. 6; pg. 7, lines 1-21).

Dependent claim 51 is directed to the message format of independent claim 39 in which the at least one graphical part comprises at least one of an image or a picture (e.g., element 51 and element 52 of FIG. 5; FIG. 6; pg. 7, lines 1-21).

Dependent claim 52 is directed to the method of independent claim 15 in which the at least one graphical icon part comprises an animation sequence (e.g., pg. 9, lines 30-32; pg. 10, lines 1-21).

Dependent claim 53 is directed to communication terminal of independent claim 16 in which the at least one graphical icon part comprises an animation sequence (e.g., pg. 9, lines 30-32; pg. 10, lines 1-21).

Dependent claim 54 is directed to the message format of independent claim 25 in which the at least one graphical icon part comprises an animation sequence (e.g., pg. 9, lines 30-32; pg. 10, lines 1-21).

Dependent claim 55 is directed to the method of independent claim 29 in which the at least one graphical icon part comprises an animation sequence (e.g., pg. 9, lines 30-32; pg. 10, lines 1-21).

Dependent claim 56 is directed to the communication terminal of independent claim 30 in which the at least one graphical part comprises an animation sequence (e.g., pg. 9, lines 30-32; pg. 10, lines 1-21).

Dependent claim 57 is directed to the message format of independent claim 39 in which the at least one graphical part comprises an animation sequence (e.g., pg. 9, lines 30-32; pg. 10, lines 1-21).

6. *Grounds of Rejection to be Reviewed on Appeal.*

- (i) Claims 15, 29, 39, 40, 43, 45, 46, 49 and 51 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over International Publication No. WO 97/19429 to Deluca et al. (hereinafter “Deluca”) in view of U.S. Patent No. 6,044,248 to Mochizuki (hereinafter “Mochizuki”) further in view of U.S. Patent No. 6,421,707 to Miller (hereinafter “Miller”).

(ii) Claims 52, 55 and 57 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Deluca in view of Mochizuki further in view of Miller further in view of U.S. Patent No. 6,032,025 to Sugio et al. (hereinafter “Sugio”).

(iii) Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54 and 56 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sugio in view of Mochizuki further in view of Miller.

(iv) Claims 17, 18, 26, 27, 28, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sugio in view of Mochizuki further in view of Miller further in view of U.S. Patent No. 6,047,828 to Medina (hereinafter “Medina”).

Appellant hereby appeals all of the rejections of Claims 15-57.

7. ***Argument.***

A. Claims 15, 29, 39, 40, 43, 45, 46, 49 and 51 are patentable over Deluca, Mochizuki & Miller

As a brief summary, Appellant respectfully submits that the cited references, alone or in combination, do not teach or suggest the claims of the present application. Appellant submits that, in particular, Deluca, Mochizuki and Miller, either alone or in combination, fail to teach or suggest 1) generating a compound message including a text part and at least one graphical icon part and transmitting the message which includes the text part and the at least graphical icon part via the wireless network and 2) “adding a graphical part to the message, the ... graphical part including ... at least one graphical icon part in a graphical format, ... the ... graphical icon part in the text part” and 3) transmitting of the message via the wireless network, as recited in various manners by the independent claims as described below.

The claimed invention as recited by independent claims 15, 16, 25, 29, 30 and 39 provides a communication terminal, message format and method for handling messages transmitted between communication terminals via a wireless network. Independent claim 15, for example recites, “[a] method for handling messages transmitted between communication terminals via a wireless network.” The method comprises “*generating a compound message including a text part and at least one graphical icon part.*” “[T]he compound message generation including reading a user inputted text part and converting the inputted text part into a

predefined message text format,” and “adding a graphical part to the message.” “[T]he graphical part includ[es] a record for each of the *at least one graphical icon part in a graphical format*.” The method further comprises “adding position information in the message defining a position of the *at least one graphical icon part in the text part*” and “transmitting of the message via the wireless network.”

Appellant submits that the combination of Deluca, Mochizuki and Miller does not teach or suggest all of the recitations of claim 15. On pg. 15 of the Final Office Action dated May 24, 2007, the Examiner continues to rely on pg. 5, lines 13-14 of Deluca, alone or in combination with Mochizuki and Miller, as disclosing generating a compound message including a text part and at least one graphical icon part. Appellant disagrees and submits that the Examiner is giving Deluca, alone or in combination with Mochizuki and Miller, credit for more than it actually teaches. In contrast to claim 15, Deluca, at best, discloses messages that are transmitted to a data communication receiver 100 in which the transmitted message includes a numerical code (e.g., “TOM?#07”) which is utilized to identify image data, that is prestored by the data communication receiver 100, with the code being selected by a message composer at a transmitting device 305 which sends the message to the receiver 100. (pgs. 4 & 5 of Deluca; See also FIG. 8) In this regard, for example, Deluca, at best, discloses that the “code ‘#01’ is associated with image data that represents the image of a telephone” and that ‘#02’ is associated with a house while ‘#03’ is associated with an office.” (See pg. 4, lines 31-34 & graphics database 155 of FIGS. 1 & 2 of Deluca) Deluca explains that upon receipt of the message, the data communication receiver 100 uses the numerical code to identify and retrieve the corresponding image data from its graphics database 155, thereby eliminating a need to transmit any information to the data communication receiver 100 beyond the numerical code to cause the display of the image data. Deluca, alone or in combination with Mochizuki and Miller, does not disclose any transmitted message which contains a “graphical part including ... at least one graphical icon part in a graphical format, as required by claim 15, but rather, at best, discloses that a transmitted message contains only text, e.g., code “#07”. In this regard, page 5, lines 13-14 of Deluca, describes a message containing only text, “for example, alphanumeric characters.” More particularly, pg. 5, lines 13-14 of Deluca explains that “alphanumeric or numeric characters [are] included in the message” and discusses that the “[r]eception of a display command for a message comprising the characters of “#07TOM?” results in subsequent presentation of the image associated with the code “#07” at display 130 of the data communication receiver 100.

(emphasis added) Deluca, at best, discloses that the data communication receiver 100 recognizes alphanumeric code “#07” in the message and retrieves corresponding image data, i.e., coffee mug based on the code, which is previously stored in a graphics database 155 of the receiver 100. (See FIG. 2 of Deluca)

Page 6, lines 31-36 of Deluca, alone or in combination with Mochizuki and Miller, describes that the “message [therein] does include one or more codes associated with a graphic message, the presentation element 150” of the data communication receiver 100 “compares . . . each code included in the message to the entries in the graphics database 155 (FIG. 1)” and “[w]hen a code in the message is determined to be equivalent to a code in the database 155, the image data associated with the matching code is retrieved and used . . . presenting the image to the user” via display 130. (pg. 7, line 1 of Deluca) Deluca also explains that the “message [sent by the terminal 305] includes text in addition to the graphic message code or codes.” (pg. 7, lines 1-3 of Deluca) (emphasis added) Since Deluca, at best, discloses that a terminal such as terminal 305 transmits a message including text and one or more codes to a receiver 100 which retrieves an associated image (e.g., coffee mug) stored locally in its database to display an image at the receiver 100, Deluca, alone or in combination with Mochizuki and Miller as described below, is incapable of teaching or suggesting “generating a *compound message including a text part and at least one graphical icon part . . . in a graphical format*” and “*transmitting . . . the message*” which *includes a text part and at least one graphical icon part* “via the wireless network,” as required by claim 15. Appellant submits that transmission of a message including text and one or more codes is not tantamount to transmission of any graphical icon and text in a message, as claimed. For at least this reason, Deluca, alone or in combination is deficient and does not teach or suggest all of the features of claim 15. Moreover, Deluca (and Mochizuki and Sugio with respect to claim 16 for that matter) requires that the receiver 100 actually store a database 155 with codes to retrieve corresponding images whereas claim 15 describes transmission of the compound message including the text part and at least one graphical icon part in a graphical format irrespective of any receiving device having a database or memory with images associated with codes that are used to display the corresponding images.

In contrast to claim 15 and in view of the foregoing, Deluca, at best, discloses that any graphical part corresponding to the transmitted numerical code is retrieved from a memory (i.e., graphics database) and displayed after the message is received at the receiver 100. Deluca, at best,

discloses only messages that include either (1) a numerical code, e.g., "#07" (pg. 5); (2) a numerical code and any desired additional text to be displayed at the receiving device, e.g., "TOM?#07" (pg. 5; pg. 7, lines 1-3) (as discussed above); or (3) a numerical code and any desired additional numerals to be displayed at the receiver 100, e.g., "#073331111" (pg. 5). Deluca, at best, discloses that the numerical code use "predetermined characters ... found on conventional telephone receivers." (pg. 3, lines 30-31) A skilled artisan would consider the messages of Deluca to include only "alphanumeric or numeric characters" as specifically described in Deluca. (pg. 5, lines 13-18 of Deluca) In view of the foregoing, the messages taught by Deluca include only text and do not include a graphical icon part in a graphical format that is transmitted in a message, as claimed. As such, the combination of Deluca, Mochizuki and Miller does not teach or suggest "generating a *compound message* including *a text part* and at least one *graphical icon part* ... *in a graphical format* ... and "transmitting of the [compound] message via a wireless network," as required by claim 15. On pg. 2 of the Advisory Action dated September 5, 2007, the Examiner asserts that "features upon which "[A]pplicant relies (i.e., the actual transmitting of the graphic icon are not recited in the rejected claim(s)." Appellant disagrees. Independent claim 15 clearly and specifically recites "*a compound message including a text part and at least one graphical icon part ... in a graphical format ... and transmitting ... the message,*" which "*includ[es] a text part and at least one graphical icon part,*" "*via the wireless network.*" As such, the Examiner's assertion is rebutted and for at least the reasons above the combination is deficient and does not teach or suggest all of the features of claim 15.

Appellant points out that the Examiner continues to rely on Mochizuki to make up for the deficiencies of Deluca. Appellant again disagrees. Similar to Deluca, Mochizuki, at best, discloses a call receiver (See FIG. 1 of Mochizuki) which receives a transmitted message that includes a "graphic image unit code and a character data code." (Col. 2, lines 1-10 of Mochizuki) Like Deluca, Mochizuki, at best, explains that the graphic image code is a numeric code corresponding to a predefined illustration residing in the receiving device. (Col. 2, lines 1-10 of Mochizuki) The receiver of Mochizuki includes a code memory storing graphic image units and graphic image unit codes. Mochizuki discusses that code information is extracted from a message. The code information includes a graphic image unit code and a character data code. Mochizuki explains that "[b]ased on the code information, a graphic image unit corresponding to the graphic image unit code and a piece of character data ... are read from the code memory"

108 “and then the message with the graphic image unit and the piece of character data is displayed.” (Col. 2, lines 1-10 & FIG. 1 of Mochizuki) However, as discussed at length above, sending a message with a graphic image code and a character code to a receiver which uses the code to find an associated image stored locally in its memory, i.e., graphic image code memory 108, is not tantamount to “generating a compound message including a text part and at least one graphical icon part … in a graphical format” and “transmitting … the message” which includes the text part and the at least one graphical icon part in a graphical format “via the wireless network,” as required by claim 15.

Moreover, FIGS. 4A and 4B of Mochizuki show that the graphic image codes are alphanumeric codes e.g., “01”, “02”, “03”, etc. Nowhere in Mochizuki, alone or in combination, is there any mention, teaching or suggestion that the graphic image codes are graphic images or graphic icon parts in a graphical format, as claimed. Rather, column 6, lines 57-67 of Mochizuki describes that the processor 104 asks the user whether to input a desired graphic image code in the transmission message. As such, the processor stores the selected graphic image code (GIC) (See “01,” - “08” in FIGS. 4A & 4B) in the message that is to be transmitted to the “selective call receiver.” In view of the foregoing, Mochizuki, alone or in combination with Deluca and Miller, still fails to teach or suggest generation of “a compound message *including* a text part *and at least one graphical icon part* … in a graphical format,” “and *transmitting … the message* via the … network,” as required by claim 15.

On pg. 2 of the Advisory Action, the Examiner posits that Mochizuki discloses “transmitting of the message via the wireless network” allegedly because the “same message constructed on the sender side … is transmitted to the receiver … through a wireless network.” Even if it were assumed for the sake of argument in this case (an assumption in which Appellant expressly disagrees) that Mochizuki discloses that a message is transmitted through a wireless network, Mochizuki, like Deluca, does not teach or suggest “generating a *compound message* including *a text part* and at least *one graphical icon part* … in a graphical format … and transmitting *the [compound] message* via the … network,” as claimed. Mochizuki, like Deluca does not contemplate transmitting any messages containing text and any graphical icon part in a graphical format, as claimed. Rather, any images are stored at the receiver and retrieved by the receiver for display on the basis of the graphic image codes that are transmitted in the message.

For at least this additional reason, the combination is deficient and does not teach or suggest all of the features of claim 15.

Appellant points out that the Examiner correctly concedes that “Deluca and Mochizuki both fail to teach [a] graphical icon part is in a graphical format” but the Examiner relies on Miller to make up for the deficiencies of Deluca and Mochizuki. (See pg. 3 of the Final Office Action dated May 24, 2007) In particular, the Examiner asserts that “Miller … teaches transmitting messages that include [a] graphical image.” (See *id.*) Appellant again disagrees and submits that the Examiner is giving Miller, alone or in combination with Deluca and Mochizuki, credit for more than it actually teaches. In contrast to claim 1, Miller, at best, discloses a multimedia message and multimedia attachments that may be received by a network and delivered to a device 411 of a subscriber. In this regard, column 1, lines 31-62 of Miller, (a portion of which is relied upon by the Examiner namely “column 1, lines 31-35”) at best, discloses that the multimedia attachments may consist of text, speech, fax, image, [and] video” data. (Col. 1, lines 34-62) Miller describes that the multimedia messages may be a plain text file 404, a common graphics file 405 (e.g., “Power-Point”) and sound file 406 in .wav format. (Col. 4, lines 29-35 of Miller)

Appellant points out that claim 15 recites “generating a compound message including a text part and at least one graphical icon part … in a graphical format … the at least one graphical *icon part in the text part …*”

In contrast to claim 15, column 4, lines 26-35, and indeed all of Miller, alone or in combination, at best, describes that when a subscriber (e.g., Radhika) sends an e-mail with multimedia attachments to another subscriber (e.g., Thomas) the “attachments 404, 405 and 406 [are] in the upper panel” of an internet browser screen and are not in the text of the message “shown in the scrollable text window 403,” as required by claim 15. As shown in FIGS. 4(h) & 4(i) of Miller, the text message received from a subscriber, such as Radhika, at device 411 is entirely separate and distinct from the graphics file attachment 406 such as the Power-Point attachment. In other words, the graphics file attachment is not in the text message or in the text of the text message, as clearly shown in FIGS. 4(h) & 4(i) of Miller and as required by claim 15. FIG. 4(i) of Miller clearly shows that the graphics file attachment 405 (i.e., “4:PowerPoint (64K)”) is not within the text message 404 shown in FIG 4(h) (i.e., “Hello Thomas, I am enclosing a copy of a recent luc”), as

required by claim 15. Nowhere in Miller, alone or in combination, is there any mention, teaching or suggestion relating to any graphics file attachment that is in a text part of a compound message, as claimed. As such, Miller, alone or in combination with Deluca and Mochizuki, does not teach or suggest “at least one graphical *icon part* [that is] in a *graphical* format ... “the ... graphical icon part *in the text part*,” as required by claim 15. In view of the foregoing, Appellant submits that the combination of Deluca, Mochizuki and Miller are deficient and does not teach or suggest all of the features of claim 15.

To establish, a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must show that the prior art references, when combined, teach or suggest all of the claim recitations. (See MPEP § 2143) Here, as demonstrated above, the prior art references, even when combined simply do not teach or suggest all of the features of independent claim 15.

Thus, for at least all of the foregoing reasons, the combination of Deluca, Mochizuki and Miller is deficient and does not teach or suggest all of the features of claim 15. As such, it is respectfully submitted that independent claim 15 is patentable over the references either individually or in combination. Since independent claims 29 and 39 contain features that are analogous to, though not necessarily coextensive with, the features recited in claim 15, Appellant submits that independent claims 29 and 39 are patentable at least for reasons analogous to those submitted for independent claim 15.

Claims 40, 46, 52, 43, 49, 55, and 45, 51 and 57 depend either directly or indirectly from corresponding independent claims 15, 29 and 39 and thus include all the recitations of their corresponding independent claims. Therefore, dependent claims 40, 46, 52, 43, 49, 55, 45, 51 and 57 are patentable for at least the same reasons given above for independent claims 15, 29 and 39.

Accordingly, Appellant respectfully requests reversal of the rejections of claims 15, 40, 46, 52, 29, 43, 49, 55 and 39, 45, 51 and 57.

B. Dependent Claims 52, 55 & 57 are patentable over Deluca, Mochizuki, Miller & Sugio

As discussed above, Deluca, Mochizuki and Miller, either alone or in combination, are deficient vis-à-vis independent claims 15, 29 and 39. Sugio et al. (U.S. Patent No. 6,032,025; hereinafter “Sugio”) does not make up for the deficiencies of Deluca, Mochizuki and Miller,

alone or in combination, and is not cited for such. Accordingly, claims 52, 55 and 57 are patentable at least by virtue of their respective dependencies from independent claims 15, 29 and 39. Appellant therefore respectfully requests reversal of the rejection of dependent claims 52, 55 and 57.

C. Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54 & 56 are patentable over Sugio, Mochizuki and Miller

Appellant submits that the combination of Sugio, Mochizuki and Miller does not teach or suggest all of the features of independent claim 16. Claim 16 requires “[a] communication terminal for handling messages comprising,” *inter alia*, “a user interface through which the user operates the terminal, the user interface including a display message editor application allowing the user to generate a compound message including a text part and at least one graphical icon part; and wherein the controller generates the compound message for being transmitted via the transceiver including a text part in a predefined message text character format, a graphical part including a record for each of the at least one graphical icon part in a graphical format, and information in the message defining a position of the at least one graphical icon part in the text part.”

In contrast to claim 16, Sugio, alone or in combination, at best, discloses the display of a message, including a portrait image, on a receiving device (e.g., pager 4). Similar to Deluca and Mochizuki, the portrait image that is ultimately displayed on the receiving device of Sugio is not contained in the message that is transmitted to the receiving device i.e., the pager 4. Rather, the transmitted message contains an alphanumeric “image designating code,” (e.g., “portrait codes” “21” to “36” (See FIG. 4 of Sugio)) which is analogous to the numerical code of Deluca and Mochizuki. This image designating code of Sugio causes the pager 4 to retrieve from memory (e.g. portrait table stored in ROM 19) and display a portrait image corresponding to the transmitted and received image designating code (e.g., portrait code 21). (See Abstract; Col. 2, lines 30-56 of Sugio; Col. 6, lines 27-34 of Sugio). Sugio, at best, discloses that the message may include “characters, numerals, and symbols.” (See Col. 2, lines 32-33 of Sugio). For instance, a message may contain the numerals and symbols “*5*528,” which causes a predefined portrait (i.e., portrait 28) to be displayed on the pager 4 (See Col. 9, lines 24-34; FIG. 8 of Sugio).

Additionally, Appellant again points out that FIGS. 36A-36E (among others) and the corresponding description, indicate that only the image designating code (illustrated in the transmission code display section 243 and containing only numerals and symbols), and not the actual image itself, is transmitted in the message from a device to the pager 4. (See Col. 24, lines 39-42; FIGS. 36A-36E of Sugio).

In contrast to claim 1, Sugio, discloses that the “pager comprises a receiver for receiving an image designating code together with a message ... a memory for storing a plurality of images, ... [and] based on the image designating code received by the receiver, selecting an associated image from [a memory of the receiver] and displaying the image together with the message.” (Col. 2, lines 4-13 & Abstract of Sugio) (emphasis added) In view of the foregoing, Appellant again submits that Sugio, either alone or in combination with Mochizuki and Miller, simply does not teach or suggest that the messages disclosed therein include a text part and a graphical icon part in a graphical format, as claimed. Moreover, since Sugio, at best, discloses that the message includes a “an image designating code” that is sent by a device and received by the pager 4 which uses the code to locate a corresponding image in memory and display the image with the message, Sugio, alone or in combination with Mochizuki and Miller also fails to teach or suggest “a display message editor application ... to generate a *compound message including a text part and at least one graphical icon part*, ... in a graphical format”, the compound message ... being transmitted via the transceiver,” as required by claim 16. As discussed at length above, transmitting a message containing an image designating code and text is not tantamount or equivalent to transmitting a compound message including a text part and at least one graphical icon part in a graphical format, as required by independent claim 16. Like Deluca and Mochizuki, there simply is no message in Sugio, either alone or in combination, which includes a text part and a graphical icon part in a graphical format that is transmitted, as required by claim 16. For at least this reason, the combination of Sugio, Mochizuki and Miller is deficient and does not teach or suggest all of the features of claim 16.

Appellant points out that the Examiner correctly concedes that Sugio does not teach or suggest all of the features of claim 16. However, the Examiner relies on Mochizuki and Miller to make up for the deficiencies of Sugio. (See pg. 6 of the Final Office Action dated May 24, 2007) Appellant again disagrees and submits that neither Mochizuki nor Miller, alone or in combination, make up for the deficiencies of Sugio. Rather, the Examiner is simply giving

Mochizuki and Miller, alone or in combination with Sugio credit for more than the references actually teach.

Appellant notes that claim 16 recites “a display message editor application … to generate a *compound message* including *a text part* and at *least one graphical icon part* … in a graphical format”, “the at least one graphical icon part *in the text part*” and “the *compound message*” which “include[es] a text part and at least one graphical icon part … being *transmitted* via the *transceiver* …” Since independent claim 16 contains features that are analogous to, though not necessarily coextensive with the features required by claim 15, Appellant submits that Mochizuki and Miller and does not make up for what Sugio lacks for at least the same reasons as those discussed above with respect to independent claim 15.

Thus, for at least all of the foregoing reasons, the combination of Sugio, Mochizuki and Miller is deficient and does not teach or suggest all of the features of independent claim 16. As such, it is submitted that independent claim 16 is patentable over the references either individually or in combination. Since independent claims 25 and 30 contain features that are analogous to, though not necessarily coextensive with, the features recited in independent claim 16, Appellant submits that independent claims 25 and 30 are patentable for at least the same reasons given above for independent claim 16.

Claims 17, 18, 19, 20, 21, 22, 23, 24, 26, 27, 28, 41, 47 and 53 as well as claims 42, 48, 54 and 31-38, 44, 50 and 56 depend either directly or indirectly from corresponding independent claims 16, 25 and 30 and thus include all the recitations of their corresponding independent claims. Therefore, dependent claims 17, 18, 19, 20, 21, 22, 23, 24, 26, 27, 28, 41, 47 and 53 as well as claims 42, 48, 54 and 31-38, 44, 50 and 56 are patentable for at least the same reasons given above for independent claims 16, 25 and 30.

Accordingly, Appellant respectfully requests reversal of the rejections of claims 16-24, 26-28, 41, 47, and 53 as well as claims 25, 42, 48, 54 and 30-38, 44, 50 and 56.

With further regard to claims 46-51 and 52-57, Appellant submits that at least these claims recite independently patentable subject matter given that the combination of Sugio, Mochizuki and Miller also fails to teach or suggest “wherein the at least one graphical icon part comprises at least one of an image or a picture,” as recited by claims 46-51 and “wherein the at least one graphical icon part comprises an animation sequence,” as required by claims 52-57. The Examiner relies on column 1, lines 31-35 of Miller as allegedly disclosing a graphical icon

part comprising an image or a picture. (See pg. 9 of the Final Office Action dated May 24, 2007) Claims 47, 48 and 50 (in combination with other elements of the claims) require “a compound message including a text part and at least one graphical part … the at least *one graphical icon part in the text part*” “wherein the at least one graphical icon part comprises at least one of an image or a picture” that is transmitted in the compound message. As discussed at length above, the graphics image file of Miller is not included in the text of a compound message, as claimed. Additionally, since Sugio and Mochizuki, at best, disclose transmitting a message to a receiver with alphanumeric or numeric codes and text and does not disclose transmitting a graphical icon part in a graphical format and text in a message, neither Sugio nor Mochizuki make up for the deficiencies of Miller. As such, neither Sugio, Mochizuki, or Miller, alone or in combination teach or suggest generating a compound message including a text part and at least one graphical icon part … in a graphical format” “wherein the at least *one graphical icon part comprises* at least one of *an image or a picture*, “the at least one graphical icon part *in the text part*” and *transmitting* the compound message, which includes the image or the picture, as required by claims 46-51. For at least this additional reason, Sugio, alone or in combination with Mochizuki and Miller, is deficient and does not teach or suggest all of the features of dependent claims 46-51. Appellant therefore requests that the § 103(a) rejection of claims 46-51 be reversed and withdrawn.

The Examiner relies on column 42, lines 19-22 of Sugio as allegedly disclosing a graphical icon part which comprises an animation sequence. (See pg. 9 of the Final Office Action dated May 24, 2007) The cited portion and indeed all of Sugio, at best, describes “a plurality of portraits [that] are switched from one another … providing a dynamic picture portrait.” Claims 52-57, in combination with other elements of the claims, recite “a compound message including a text part and at least one graphical part … the at least *one graphical icon part in the text part*” “wherein the at least one graphical part comprises an animation sequence” and transmitting the compound message which includes the text part and the animation sequence. Even assuming *arguendo* that the dynamic picture portrait of Sugio is an animation, (an assumption with which Appellant expressly disagrees) the combination still does not teach or suggest all of the features of claims 52-57 given that Sugio either alone or in combination with Mochizuki and Miller fails to teach or suggest that the dynamic picture portrait (alleged animation sequence) is in the message that is transmitted to the receiver i.e., page 4. Rather,

Sugio, alone or in combination, at best, discloses that any images or portraits are retrieved from a locally stored memory, of the pager 4, on the basis of the image designating codes disclosed therein. For at least these additional reasons, Sugio, alone or in combination with Mochizuki and Miller, is deficient and does not teach or suggest all of the features of dependent claims 52-57. Appellant therefore requests that the § 103(a) rejection of claims 52-57 be reversed and withdrawn.

D. Dependent Claims 17, 18, 26, 27, 28, 31 and 32 are patentable over Sugio, Mochizuki, Miller and Medina

As discussed above, Sugio, Mochizuki and Miller are deficient vis-à-vis independent claims 16, and 30. Medina (U.S. Patent No. 6,047,828) does not make up for the deficiencies of Sugio, Mochizuki and Miller and is not cited for such. Accordingly, claims 17, 18, 26, 27, 28, 31 and 32 are patentable at least by virtue of their respective dependencies from independent claims 16 and 30. Appellant therefore respectfully requests reversal of the rejection of dependent claims 17, 18, 26, 27, 28, 31 and 32.

E. Conclusion

Since none of the cited references, alone or in combination, teach or suggest all of the features recited in independent claims 15, 16, 25, 29, 30 and 39, the cited references, either individually or in combination, fail to render independent claims 15, 16, 25, 29, 30 and 39 obvious for the reasons described above. Claims 40, 46, 52 and 17, 18, 19, 20, 21, 22, 23, 24, 26, 27, 28, 41, 47, 53 as well as claims 42, 48, 54 and 43, 49, 55 and claims 31-38, 44, 50, 56, as well as claims 45, 51, 57 depend either directly or indirectly from independent claims 15, 16, 25, 29, 30 and 39, respectively, and thus include all of the recitations of their respective independent claims. Therefore, dependent claims 40, 46, 52 and 17, 18, 19, 20, 21, 22, 23, 24, 26, 27, 28, 41, 47, 53 as well as claims 42, 48, 54 and 43, 49, 55 and claims 31-38, 44, 50, 56, as well as claims 45, 51, 57 are patentable for at least those reasons given above for the independent claims.

Accordingly, for all the reasons stated above, Appellant respectfully requests that the rejections of claims 15-57 be reversed.

8. ***Claims Appendix.***

The claims currently on appeal are as follows:

Claims 1-14 (cancelled)

15. (Previously Presented) A method for handling messages transmitted between communication terminals via a wireless network comprising:

generating a compound message including a text part and at least one graphical icon part, the compound message generation including reading a user inputted text part and converting the inputted text part into a predefined message text format, adding a graphical part to the message, the graphical part including a record for each of the at least one graphical icon part in a graphical format, and adding position information in the message defining a position of the at least one graphical icon part in the text part; and

transmitting of the message via the wireless network.

16. (Previously Presented) A communication terminal for handling messages comprising:

a controller, a transceiver for communicating with a wireless communication network, and a user interface through which the user operates the terminal, the user interface including a display message editor application allowing the user to generate a compound message including a text part and at least one graphical icon part; and wherein

the controller generates the compound message for being transmitted via the transceiver including a text part in a predefined message text character format, a graphical part including a record for each of the at least one graphical icon part in a graphical format, and information in the message defining a position of the at least one graphical icon part in the text part.

17. (Previously Presented) A communication terminal according to claim 16, wherein the message generated by the controller includes a header part including the position information.

18. (Previously Presented) A communication terminal according to claim 17, wherein the header part of the message furthermore includes information about graphics size.

19. (Previously Presented) A communication terminal according to claim 16, wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons.

20. (Previously Presented) A communication terminal according to claim 16, comprising a message reader application for automatically converting a received compound message into a displayable format based on the text part and the at least one graphical icon part.

21. (Previously Presented) A communication terminal according to claim 19, wherein the message reader application includes means for allowing the user to store the at least one graphical part in the memory associated with the controller and containing a plurality of graphical icons.

22. (Previously Presented) A communication terminal according to claim 16, wherein the message editor application allows the user to manually generate a graphical icon on the display by selectively marking dots in an icon matrix.

23. (Previously Presented) A communication terminal according to claim 22, wherein the message editor application allows the user to store a manually entered graphical icon in the memory associated with the controller and containing a plurality of graphical icons.

24. (Previously Presented) A communication terminal according to claim 16, wherein the message editor application allows the user to input a plurality of graphical parts in the graphical part of the message and information in the message to display the plurality of graphical parts as an animation sequence.

25. (Previously Presented) A message format including a text part and at least one graphical icon part, comprising:

a text part in a predefined message text character format;

a graphical part including a record for each of the at least one graphical icon part in a graphical format; and

information in the message defining a position of the at least one graphical icon part in the text part.

26. (Previously Presented) A communication terminal according to claim 17, wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons.

27. (Previously Presented) A communication terminal according to claim 18, wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons.

28. (Previously Presented) A communication terminal according to claim 17 comprising:

a header part of the message including information about graphics size.

29. (Previously Presented) A method for handling messages transmitted between communication terminals via a wireless network comprising:

generating a compound message including a text part and at least one graphical part, the compound message generation including reading a user inputted text part and converting the inputted text part into a predefined message text format, adding a graphical part to the message, the graphical part including a record for each of the at least one graphical part in a graphical format, and adding position information in the message defining a position of the at least one graphical part in the text part; and

transmitting of the message via the wireless network.

30. (Previously Presented) A communication terminal for handling messages and comprising:

a controller, a transceiver for communicating with a wireless communication network, and a user interface through which the user operates the terminal, the user interface including a display message editor application allowing the user to generate a compound message including a text part and at least one graphical part; and wherein

the controller generates the compound message for being transmitted via the transceiver including a text part in a predefined message text character format, a graphical part including a record for each of the at least one graphical part in a graphical format, and information in the message defining a position of the at least one graphical icon part in the text part.

31. (Previously Presented) A communication terminal according to claim 30, wherein the message generated by the controller includes a header part including the position information.

32. (Previously Presented) A communication terminal according to claim 31, wherein the header part of the message furthermore includes information about graphics size.

33. (Previously Presented) A communication terminal according to claim 30, wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons.

34. (Previously Presented) A communication terminal according to claim 30, comprising a message reader application for automatically converting a received compound message into a displayable format based on the text part and the at least one graphical icon part.

35. (Previously Presented) A communication terminal according to claim 30, wherein the message reader application includes means for allowing the user to store the at least one graphical part in the memory associated with the controller and containing a plurality of graphical parts.

36. (Previously Presented) A communication terminal according to claim 30, wherein the message editor application allows the user to manually generate a graphical part on the display by selectively marking dots in a matrix.

37. (Previously Presented) A communication terminal according to claim 36, wherein the message editor application allows the user to store a manually entered graphical icon in the memory associated with the controller and containing a plurality of graphical icons.

38. (Previously Presented) A communication terminal claim 30, wherein the message editor application allows the user to input a plurality of graphical parts in the graphical part of the message and information in the message to display the plurality of graphical parts as an animation sequence.

39. (Previously Presented) A message format including a text part and at least one graphical part, comprising:

- a text part in a predefined message text character format;
- a graphical part including a record for each of the at least one graphical part in a graphical format; and
- information in the message defining a position of the at least one graphical part in the text part.

40. (Previously Presented) The method of claim 15, wherein the position information further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text part is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned following the at least one graphical icon part.

41. (Previously Presented) The communication terminal of claim 16, wherein the information in the message further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text part is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned

following the at least one graphical icon part.

42. (Previously Presented) The message format of claim 25, wherein the information in the message further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text part is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned following the at least one graphical icon part.

43. (Previously Presented) The method of claim 29, wherein the position information further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text part is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned following the at least one graphical icon part.

44. (Previously Presented) The communication terminal of claim 30, wherein the information in the message further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text part is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned following the at least one graphical icon part.

45. (Previously Presented) The message format of claim 39, wherein the information in the message further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text part is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned following the at least one graphical icon part.

46. (Previously Presented) The method of claim 15, wherein the at least one graphical icon part comprises at least one of an image or a picture.

47. (Previously Presented) The communication terminal according to claim 16, wherein the at least one graphical icon part comprises at least one of an image or a picture.

48. (Previously Presented) The message format of claim 25, wherein the at least one graphical icon part comprises at least one of an image or a picture.

49. (Previously Presented) The method of claim 29, wherein the at least one graphical part comprises at least one of an image or a picture.

50. (Previously Presented) The communication terminal of claim 30, wherein the at least one graphical part comprises at least one of an image or a picture.

51. (Previously Presented) The message format of claim 39, wherein the at least one graphical part comprises at least one of an image or a picture.

52. (Previously Presented) The method of claim 15, wherein the at least one graphical icon part comprises an animation sequence.

53. (Previously Presented) The communication terminal according to claim 16, wherein the at least one graphical icon part comprises an animation sequence.

54. (Previously Presented) The message format of claim 25, wherein the at least one graphical icon part comprises an animation sequence.

55. (Previously Presented) The method of claim 29, wherein the at least one graphical part comprises an animation sequence.

56. (Previously Presented) The communication terminal of claim 30, wherein the at least one graphical part comprises an animation sequence.

57. (Previously Presented) The message format of claim 39, wherein the at least one graphical part comprises an animation sequence.

9. ***Evidence Appendix.***

None.

10. ***Related Proceedings Appendix.***

None.

CONCLUSION

For at least the foregoing reasons, Appellant respectfully requests that the rejections be reversed.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Cory C. Davis
Registration No. 59,932

CUSTOMER No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777
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